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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/764,118 | 01/19/2001 | Kazutoshi Ishikawa | 1247-0444P | 8125 |
| 7590 | 07/01/2004 | | | |
| BIRCH, STEWART, KOLASCH & BIRCH, LLP P.O. Box 747 Falls Church, VA 22040-0747 | | | EXAMINER CARTER, TIA A | |
| | | | ART UNIT 2626 | PAPER NUMBER 5 |

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,118

Applicant(s)

ISHIKAWA ET AL.

Examiner

Tia A Carter

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3,4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka (US. 6424425) in view of Hiroki et al. (US. 6594032)

Regarding claim 1, Otsuka discloses a facsimile apparatus (see fig. 2) comprising:

Facsimile sending/receiving means (fig. 2, ref. 44) or sending and receiving image data by facsimile over a connected public switched telephone network (fig. 2, col. 4, lines 37-41);

Reading means (fig. 1, scanner 19) for reading image data (fig. 1, col. 4, lines 1-2 and line 29);

Printing means for (fig. 3, Ink-jet printer 26) printing image data (fig. 3, col. 4, lines 20-21);

Plurality of keys (fig. 1, col. 3, lines 45-46);

A connection interface for connection to an information processing apparatus provided with the capability of sending and receiving message by email over a connected network (fig. 2, col. 4, lines 32-46);

Otsuka **do not disclose** storing means for storing key data representing a predetermined key of the plurality of keys, setting data for setting this key data to e-mail mode, and recipient name data corresponding to the key data;

Otsuka **do not disclose** sending means for sending the image data, key data, setting data, and recipient name data over the connection interface to the information processing apparatus when the predetermined key has been actuated.

Hiroki et al. **discloses** storing means (RAM-103) for storing key data representing a predetermined key of the plurality of keys, setting data for setting this key data to e-mail mode, and recipient name data corresponding to the key data (fig. 2, col. 4, lines 3-11; fig. 11, col. 7, lines 55-67; col. 8, lines 1-2 and lines 21-49); and

Hiroki et al. **discloses** sending means for sending the image data, key data, setting data, and recipient name data over the connection interface to the information processing apparatus when the predetermined key has been actuated (fig. 3, col. 4, lines 51-67 and col. 5, lines 1-10; fig. 12, col. 8, lines 14-49).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein the operational panel disclosed therein would contain additional functioning keys providing the user with a simpler and more accurate facsimile communication with plural functions. Also, corresponding communications permits the device to transmit specific data relating to the recipient and the specific mode selected.

This feature helps to maintain the system at the receiving end whereas the receiving device can be properly set up for delivery and the transmitting device will know whether the device can receive data properly.

Regarding claim 2, Otsuka discloses the facsimile apparatus of claim 1.

Otsuka **do not disclose** receiving means for receiving the key data, the setting data, and the recipient name data over the connection interface from the information processing apparatus and setting them.

Hiroki et al. **discloses** receiving means for receiving the key data, the setting data, and the recipient name data over the connection interface from the information processing apparatus and setting them (fig. 5, col. 5, lines 10- 41).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein adding a receiving means for peer-to-peer facsimile communication whereas the feature permits a transmitting device to retrieve feedback/data from its destination device. This feature allows additional devices to be connected and also provides communication for remote devices.

Regarding claim 3, Otsuka discloses the facsimile apparatus of claim 1, wherein the image data that is sent by the sending means is read in by the reading means (fig. 4, col. 6, lines 9-15).

Regarding claim 4, Otsuka discloses the facsimile apparatus of claim 1, wherein the image data sent by the sending means is image data that has been received by facsimile with the sending/receiving means (fig. 4, col. 6, lines 9-17).

Regarding claim 6, Otsuka discloses an information processing apparatus provided with a capability of sending and receiving messages by e-mail over a connected network (fig. 2, col. 4, lines 33-42; fig. 1, col. 3, lines 56-59), and connected to a facsimile apparatus comprising facsimile sending/receiving means for sending and receiving image data by facsimile over a connected public switched telephone network (fig. 2, col. 4, lines 33-39); reading means for reading images data (fig. 3, col. 4, lines 1-2); printing means for printing image data (fig. 3, col. 4, lines 20-21); and a plurality of keys (fig. 1, col. 3, lines 45-46), the information processing apparatus comprising:

Otsuka **do not disclose** storing means for storing key data representing a predetermined key of the plurality of keys that the connected facsimile apparatus is provided with, setting data for setting this key data to e-mail mode, recipient name data corresponding to the key code, and a recipient address corresponding to the key data.

Hiroki et al. **discloses** storing means for storing key data representing a predetermined key of the plurality of keys that the connected facsimile apparatus is provided with, setting data for setting this key data to e-mail mode, recipient name data corresponding to the key code, and a recipient address corresponding to the key data (fig. 2, col. 4, lines 3-11; fig. 11, col. 7, lines 55-67; col. 8, lines 1-2 and lines 21-49); and

Otsuka **do not disclose** receiving means for receiving image data, key data, setting data, and recipient name data from the connected facsimile apparatus,

Hiroki et al. **disclose** receiving means for receiving image data, key data, setting data, and recipient name data from the connected facsimile apparatus (fig. 5, col. 5, lines 10- 41),

Otsuka **do not disclose** wherein the key data matching with the key data received from the facsimile apparatus is retrieved from the storing means, it is determined whether the recipient name data corresponding to the retrieved key data match with the recipient name data received from the facsimile apparatus, and the received image data is sent by e—mail to the recipient address corresponding to the matching retrieved recipient name data.

Hiroki et al. **disclose** wherein the key data matching with the key data received from the facsimile apparatus is retrieved from the storing means, it is determined whether the recipient name data corresponding to the retrieved key data match with the recipient name data received from the facsimile apparatus, and the received image data is sent by e—mail to the recipient address corresponding to the matching retrieved recipient name data (fig. 4, col. 5, lines 34-65).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein the operational panel disclosed therein would contain additional functioning keys providing the user with a simpler and more accurate facsimile communication with plural functions. Also, adding a receiving means for peer-to-peer facsimile communication whereas the feature permits a transmitting device to retrieve

feedback/data from its destination device. This feature allows additional devices to be connected and also provides communication for remote devices.

Regarding claim 7, Otsuka discloses the information processing apparatus of claim 6, further comprising:

Otsuka **do not disclose** sending means for sending the key data, the setting data and the recipient name data to the connected facsimile apparatus

Hiroki et al. **discloses** sending means for sending the key data, the setting data and the recipient name data to the connected facsimile apparatus (fig. 3, col. 4, lines 51-67 and col. 5, lines 10; fig. 12, col. 8, lines 14-49).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein corresponding communications permits the device to transmit specific data relating to the recipient and the specific mode selected. This feature helps to maintain the system at the receiving end whereas the receiving device can be properly set up for delivery and the transmitting device will know whether the device can receive data properly.

Regarding claim 8, Otsuka discloses a method of data communication between the facsimile apparatus of claim 1 and the information processing apparatus of claim 6, comprising the steps of:

Otsuka **do not disclose** sending means for sending the image data, key data, setting data, and recipient name data from the facsimile apparatus to the information processing apparatus when actuating a predetermined key of the facsimile apparatus.

Otsuka **do not disclose** receiving the image data, key data, the setting data, and the recipient name data with the information processing apparatus from the facsimile apparatus, and sending the received image data by e-mail, based on the received key data, setting data, and recipient name data.

Hiroki et al. **discloses** sending means for sending the image data, key data, setting data, and recipient name data from the facsimile apparatus to the information processing apparatus when actuating a predetermined key of the facsimile apparatus (fig. 3, col. 4, lines 51-67 and col. 5, lines 10; fig. 12, col. 8, lines 14-49).

Hiroki et al. **discloses** receiving the image data, key data, the setting data, and the recipient name data with the information processing apparatus from the facsimile apparatus (fig. 5, col. 5, lines 10- 41), and sending the received image data by e-mail, based on the received key data, setting data, and recipient name data (fig. 4, col. 5, lines 28-65).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein the operational panel disclosed therein would contain additional functioning keys providing the user with a simpler and more accurate facsimile communication with plural functions. Also, adding a receiving means for peer-to-peer facsimile communication whereas the feature permits a transmitting device to retrieve

feedback/data from its destination device. This feature allows additional devices to be connected and also provides communication for remote devices.

Regarding claim 9, Otsuka discloses the method for data communication of claim 8.

Otsuka **do not disclose** wherein the facsimile apparatus further comprises receiving means for receiving the key data, the setting data, and the recipient name data over the connection interface from the information processing apparatus and setting them

Hiroka et al. **discloses** wherein the facsimile apparatus further comprises receiving means for receiving the key data, the setting data, and the recipient name data over the connection interface from the information processing apparatus and setting them (fig. 5, col. 5, lines 10- 41).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein the operational panel disclosed therein would contain additional functioning keys providing the user with a simpler and more accurate facsimile communication with plural functions. Also, adding a receiving means for peer-to-peer facsimile communication whereas the feature permits a transmitting device to retrieve feedback/data from its destination device. This feature allows additional devices to be connected and also provides communication for remote devices.

Regarding claim 10, Otsuka disclose the method for data communication of claim 8, wherein the image data that is sent by the sending means of the facsimile apparatus is read in by the reading means (fig. 4, col. 6, lines 9-15).

Regarding claim 11, Otsuka discloses the method for data communication of claim 8, wherein the image data sent by the sending means is image data that has been received by facsimile with the sending/receiving means of the facsimile apparatus (fig. 2, col. 4, lines 32-41).

Regarding claim 12, Otsuka discloses the method for data communication of claim 11.

Otsuka **do not disclose** wherein the facsimile apparatus comprises data deleting means for deleting the image data received by the facsimile sending/receiving means before or after printing the image data.

Hiroki et al. **disclose** wherein the facsimile apparatus comprises data deleting means for deleting the image data received by the facsimile sending/receiving means before or after printing the image data (fig. 8, col. 7, lines 19-24).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein image data is deleted upon reception of the image data to prevent a back load of unwanted data.

Regarding claim 13, Otsuka discloses the method for data communication of claim 8,

Otsuka **do not disclose** wherein the information processing apparatus comprises sending means for sending the key data, the setting data and the recipient name data to the connected facsimile apparatus.

Hiroki et al. **discloses** wherein the information processing apparatus comprises sending means for sending the key data, the setting data and the recipient name data to the connected facsimile apparatus (fig. 3, col. 4, lines 51-67 and col. 5, lines 10; fig. 12, col. 8, lines 14-49).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka wherein the operational panel disclosed therein would contain additional functioning keys providing the user with a simpler and more accurate facsimile communication with plural functions.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reifman et al. (US. 5539530), Todaka (US. 5555104), Idehara (US. 6438605) and Ho et al. are cited to show related art with respect to facsimile transmission and reception via an operational panel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tia A Carter whose telephone number is 703 - 306-5433. The examiner can normally be reached on M-F (7:00-3:30).

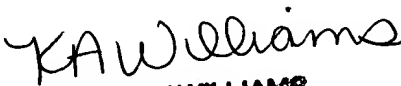
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAC
June 24, 2004

Tia A Carter
Examiner
Art Unit 2626



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER